

REMARKS/ARGUMENTS

Favorable reconsideration of this application, in light of the following discussion, is respectfully requested.

Claims 1-6, 9-15, and 18-23 are pending in the present application.

In the outstanding Office Action, Claims 1-6, 9-15, and 18-23 were rejected under the judicially created ground of non-statutory obviousness-type double patenting as unpatentable over Claims 1-10 of U.S. Patent No. 6,775,488 in view of Kuwamoto et al. (U.S. Patent No. 5,617,518, hereinafter Kuwamoto); Claims 1, 10, 19, 20, 22, and 23 were rejected under 35 U.S.C. §102(b) as anticipated by Kuwamoto; and Claims 2 and 11 were rejected under 35 U.S.C. §103(a) as unpatentable over Kuwamoto in view of Cloutier et al. (U.S. Patent No. 6,018,397, hereinafter Cloutier).

With respect to the double patenting rejection, a terminal disclaimer is filed herewith.

The filing of a Terminal Disclaimer to obviate a rejection based on nonstatutory double patenting is not an admission of the propriety of the rejection. The "filing of a Terminal Disclaimer simply serves the statutory function of removing the rejection of double patenting, and raises neither a presumption nor estoppel on the merits of the rejection." Quad Environmental Technologies Corp. v. Union Sanitary District, 946 F.2d 870, 20 U.S.P.Q.2d 1392 (Fed. Cir. 1991). Accordingly, Applicants filing of the attached disclaimer is provided for facilitating a timely resolution to prosecution only, and should not be interpreted as an admission as to the merits of the obviated rejection.

With respect to the rejection of Claim 1 as anticipated by Kuwamoto, Applicant respectfully traverses this ground of rejection. Claim 1 recites,

An image forming apparatus comprising:

a memory configured to store setting information  
including at least a size of a substitute recording medium for  
each user; and

a processor configured to execute a print instruction by automatically changing a size of a recording medium to be used to the size of the substitute recording medium based on the setting information stored in said memory, when the size of the recording medium specified by the print instruction is not available.

Kuwamoto does not disclose or suggest every element of Claim 1.

The outstanding Office Action takes the position that the claimed “setting information” equates to the print program files 700 and print program management table 500 of Kuwamoto. However, print program files 700 and print program management table 500 do not include “a size of a substitute recording medium for each user.” The document file 5000 (see Fig. 23) includes the paper size of each page.<sup>1</sup> However, this is not a size of a substitute recording medium. The paper size in the document file 5000 is the intended paper size for the print job. There is no disclosure or suggestion in Kuwamoto of a substitute for the intended paper size “when the size of the recording medium specified by the print instruction is not available.”

The outstanding Office Action relies on col. 20, lines 36-47 of Kuwamoto as describing a substitute recording medium. However, col. 20, lines 36-47 merely describes using a paper size included in the print instruction. When the paper size indicated by the print instruction is not available, there is an error and no switching to a substitute recording medium size. The invention defined by Claim 1, on the contrary, uses the substitute recording medium “when the size of the recording medium specified by the print instruction is not available” rather than executing an error process.<sup>2</sup>

The reference to a different paper size in col. 20, lines 36-47 of Kuwamoto merely indicates that one print job is of a first paper size, and a second print job has a different size. In this situation of two different print jobs, the print instruction of the second print job causes

---

<sup>1</sup> Kuwamoto, col. 17, lines 4-5.

<sup>2</sup> Compare with col. 20, lines 44-45 of Kuwamoto.

the printer to use a different paper cassette than in a previous print job. This is not a change to a substitute paper size, as the paper size is still the intended paper sized indicted by the print instruction.

In other words, Kuwamoto describes using the paper size included in the print instruction, or issuing an error message. Rather than issue an error message, the invention defined by Claim 1 changes the size of the recording medium to the size of the substitute recording medium when the intend paper size specified by the print instruction is not available.

Thus, Kuwamoto does not disclose or suggest the claimed “changing a size of a recording medium to be used to the size of the substitute recording medium based on the setting information stored in said storage, when the size of the recording medium specified by the print instruction is not available.”

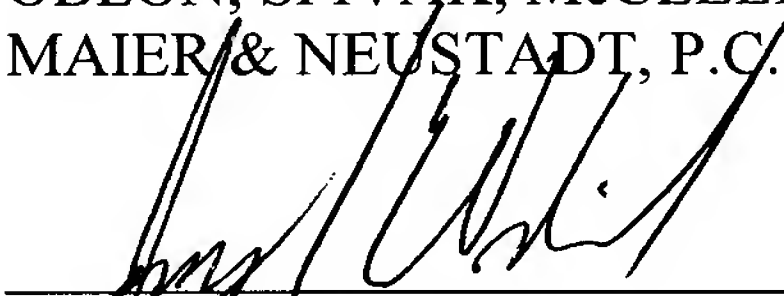
In view of the above-noted distinctions, Applicant respectfully submits that Claim 1 (and any claims dependent thereon) patentable distinguish over Kuwamoto. Claims 10, 19, 20, 22, and 23 recite elements analogous to those of Claim 1. Applicant respectfully submits that Claims 10, 19, 20, 22, and 23 (and any claims dependent thereon) patentably distinguish over Kuwamoto, for at least the reasons stated for Claim 1.

Addressing each of the further rejections, each of the further rejections is also traversed by the present response as no teachings in any of the further cited references to Cloutier can overcome the above-noted deficiencies of Kuwamoto. Accordingly, it is respectfully requested that those rejections be withdrawn for similar reasons as discussed above.

Consequently, in light of the above discussion, the present application is believed to be in condition for allowance and an early and favorable action to that effect is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.



---

James J. Kulbaski  
Attorney of Record  
Registration No. 34,648

Customer Number

**22850**

Tel: (703) 413-3000

Fax: (703) 413 -2220

(OSMMN 08/07)

I:\ATTY\JW\246853US\246853US\_AM DUE 5-29-08.DOC

Joseph Wrkich  
Registration No. 53,796